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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,300	06/25/2003	Ramon Tam	0212.67133	3228

7590 12/22/2004

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EXAMINER

PAYER, HWEI SIU CHOU

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/603,300

**Applicant(s)**

TAM ET AL.

**Examiner**

Hwei-Siu C. Payer

**Art Unit**

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 11, 12, 19-24 and 27 is/are rejected.
- 7) ☒ Claim(s) 2-10, 13-18, 25 and 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_

## Detailed Action

The preliminary amendment filed on 6-28-2004 has been entered.

### Objection to the Specification

The disclosure is objected to because of the following informalities:

(1) On page 8, lines 17-18 are incorrect. It is the swivel bracket 82 not the foot plate 22 that is located with in the chamber 78 and is oriented to engage the rear edge 84.

(2) On page 11, lines 5-6, cavity 128 cannot be found in FIG.1. It is found in FIG.2A.

Appropriate correction is required.

### Claims Objection

Claims 9, 10 and 16-18 are objected to because of the following informalities:

- (1) In claim 9, line 4, "the orbital motion" should read --an orbital motion--.
- (2) In claim 9, line 6, "the orbital action" should read --an orbital action--.
- (3) In claim 10, line 2, "said rocker" should read --said rocker member--.
- (4) In claims 16 and 17, line 2, "said lower bushing" should read --said bottom bushing--.

Appropriate correction is required.

### **Claims Rejection - 35 U.S.C. 112, second paragraph**

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 19-21 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) In claim 19, line 3, "a spherical bearing" is vague. Is it in addition to "a spherical bearing" cited at line 2 of the claim? As the disclosed invention is understood, the tool has a spherical bearing (i.e. 144 shown in Fig.2B). Where is the other "spherical bearing" shown? Also, the spherical bearing supports the plunger near the first end rather than the second end of the plunger.

(2) In claim 20, lines 1-2, "said spherical bearing" is indefinite. Is it the one cited at line 2 or at line 3 of claim 19?

(3) In claim 20, line 5, "said orbital movement" has no antecedent basis.

(4) In claim 27, "said bottom bushing" lacks clear antecedent basis. It appears claim 27 should depend from claim 25.

### **Claims Rejection – Double Patenting**

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 and 11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 28 of copending Application No. 10/376,159. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite the same invention of substantially the scope and merely differ in breadth of terminology used.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 12, 19 and 22-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 28 of copending Application No. 10/376,159 in view of Hartmann (U.S. Patent No. 4,545,123).

Claim 28 of the '159 application lacks a scotch yoke mechanism for operating an elongate plunger, a spherical bearing for supporting the plunger, and a selector mechanism including a transverse orbit pin and a scroll lock arm.

Hartmann shows a jig saw comprising a scotch yoke mechanism (74) for operating an elongate plunger (24), a spherical bearing (52) for supporting the plunger (24), and a selector mechanism (110) including a transverse orbit pin (116) and a scroll lock arm (44).

It would have been obvious to one skilled in the art to modify claim 28 of the '159 application by providing the jig saw with a scotch yoke mechanism to facilitate driving the plunger (and a saw blade connected thereto), by providing the jig saw with a spherical bearing for supporting the plunger, and by providing the jig saw with a selector mechanism with a transverse orbit pin and a scroll lock arm to facilitate selecting between a pivotal and rotational movement of the plunger in order to perform a desired cutting task as desired as taught by Hartmann.

This is a provisional obviousness-type double patenting rejection.

#### **Indication of Allowable Subject Matter**

1. Claims 2-8, 13-15 and 25-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
2. Claims 9, 10 and 16-18 are objected to as being dependent upon a rejected base claim and for minor informalities, but would be allowable if amended and rewritten in independent form including all of the limitations of the base claim and any intervening claims.
3. Claims 20, 21 and 27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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### **Prior Art Citations**

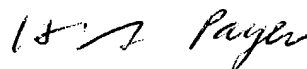
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Papworth, Clowers and Wall et al. are cited as art of interest.

### **Point of Contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hwei-Siu C. Payer whose telephone number is 571-272-4511. The examiner can normally be reached on Monday through Friday, 7:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for official communications and 571-273-4511 for proposed amendments.

H Payer  
December 9, 2004



Hwei-Siu Payer  
Primary Examiner